

### **REMARKS**

Claims 1-258 are now pending in the application. Applicants would like to thank the Examiner for courtesy extended during the personal interview conducted on January 5, 2006. During the interview, Applicants' representative and the Examiner discussed the rejection of Claim 1 in view of Aoyama and Amos. No agreement was reached. Minor amendments have been made to the specification and claims to simply overcome the objections to the specification and rejections of the claims under 35 U.S.C. § 112. The Examiner is respectfully requested to reconsider and withdraw the rejections in view of the amendments and remarks contained herein.

### **DRAWINGS**

The drawings stand objected to for certain informalities. Applicants have amended the specification to be consistent with the drawings. The objection to the drawings is rendered moot.

### **SPECIFICATION**

The specification stands objected to for certain informalities. Applicants have amended the specification according to the Examiner's suggestions. The term "step 134" in paragraph [0050] has been replaced with "step 170." Therefore, reconsideration and withdrawal of this objection are respectfully requested.

### **REJECTION UNDER 35 U.S.C. § 112**

Claims 94, 108, 117, 125, 138, 148, 157, 171, 180, 188, 201, 211 and 219 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. This rejection is respectfully traversed.

The Examiner alleges that the limitation “said second oscillator includes a semiconductor oscillator” was not described in the specification” and therefore fails to comply with the enablement requirement. Further, the Examiner alleges that “without additional details, one of ordinary skill in the art would have been burdened by undue experimentation to make or use the claimed invention. Applicants respectfully disagree.

The test of enablement is “whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation.” *United States v. Telectronics, Inc.*, 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988). Semiconductor oscillators were well known in the art at the time of the invention. Applicants respectfully submit that one reasonably skilled in the art could make or use the invention including a semiconductor oscillator with the disclosures in the patent and information known in the art.

### **REJECTION UNDER 35 U.S.C. § 102**

Claims 31, 39, 114, 120, 123, 126-128, 131, 134-135, 137, 139, 142, 145, 151, 177, 183, 186, 189-191, 194, 197-198, 200, 202, 205, 208, 214, 233, 239-241, 246-248, and 253 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Aoyama (U.S. Pat. No. 6,763,471). Claims 26, 56, 61, 69, and 86 are rejected under 35 U.S.C. 102

(b) as being anticipated by Kobayashi et al. (U.S. Pub. No. 2001/00110457). These rejections are respectfully traversed.

Aoyama does not show, teach, or suggest a wireless Ethernet network device with active and low power modes comprising first regulating means for regulating supply voltage during the active mode and that is powered down during the low power mode, second regulating means, which dissipates less power than said first regulating means, for regulating supply voltage during the low power mode, and selecting means for selecting said first regulating means during the active mode and said second regulating means during the low power mode, wherein the wireless Ethernet network device at least one of transmits and receives data during the active mode.

For anticipation to be present under 35 U.S.C §102, there must be no difference between the claimed invention and the reference disclosure as viewed by one skilled in the field of the invention. Scripps Clinic & Res. Found. V. Genentech, Inc., 18 USPQ.2d 1001 (Fed. Cir. 1991). All of the limitations of the claim must be inherent or expressly disclosed and must be arranged as in the claim. Constant v. Advanced Micro-Devices, Inc., 7 USPQ.2d 1057 (Fed. Cir. 1988). Aoyama does not disclose the limitations wherein a wireless Ethernet network device comprises the first regulating means, the second regulating means, and selecting means, wherein the wireless Ethernet network device at least one of transmits and receives data during the active mode.

Aoyama is directed to a single chip microcomputer "suitably used for an electronic device such as a video camera." (Column 1, Lines 9-11). The microcomputer includes a power supply terminal  $V_{DD}$  and first and second step-down circuits 1 and 2, as well as first and second oscillators 3 and 4. A control circuit 12

selects between  $V_{DD}$  and the first and second step-down circuits to transition between high power (i.e. high speed) and low power (i.e. low speed) modes. Similarly, Kobayashi is directed generally to “a semiconductor device.”

In contrast, Applicants’ invention is directed to a wireless device such as a wireless Ethernet network device. In particular, the wireless device includes a selecting means for selecting a first regulating means during an active mode and for selecting a second regulating means during a low power mode. As pertains specifically to a wireless Ethernet network device, the device at least one of transmits and receives data during the active mode.

Aoyama and Kobayashi are absent of any reference to wireless devices, specifically to wireless devices that at least one of transmit and receive data. As such, Aoyama and Kobayashi do not show, teach, or suggest a device that transmits and receives data during the active mode and that does not transmit or receive data during the low power mode. Applicants respectfully submit that Claims 26 and 31, as well as their dependent claims, should be allowable for at least the above reasons. Claims 56, 61, 86, 114, 123, 134, 145, 177, 186, 197, 208, 233, 239, and 246, as well as their corresponding dependent claims, should be allowable for at least similar reasons.

#### **REJECTION UNDER 35 U.S.C. § 103**

Claims 1-3, 9, 16, 21-22, 32-33, 46, and 51-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aoyama (U.S. Pat. No. 6,763,471) in combination with Amos (U.S. Pat. No. 6,934,870). This rejection is respectfully traversed.

Aoyama, singly or in combination with Amos, fails to show, teach, or suggest a wireless Ethernet network device with active and low power modes comprising a first voltage regulator that regulates supply voltage during the active mode and that is powered down during the low power mode, a second voltage regulator that dissipates less power than said first voltage regulator and that regulates supply voltage during the low power mode, and a medium access controller (MAC) device that selects said first voltage regulator during the active mode and said second voltage regulator during the low power mode, wherein the wireless Ethernet network device at least one of transmits and receives data during the active mode.

It is a longstanding rule that to establish a prima facie case of obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art. *In re Royka*, 180 USPQ 143 (CCPA 1974), see MPEP §2143.03. Here, the Examiner fails to provide **any** reference to support a finding that selecting a first voltage regulator during an active mode and selecting a second voltage regulator in a low power mode in an Ethernet network device is obvious. Furthermore, when evaluating claims for obviousness under 35 U.S.C. §103, all of the limitations must be considered and given weight. *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983), MPEP § 2144.03. Here, it is clear that the Examiner has given little or no consideration of the limitation **and failed to give the limitation any weight.**

The Examiner alleges that Aoyama discloses a wireless Ethernet network device and that it would be obvious to one skilled in the art to incorporate the controller of Aoyama with a MAC device as suggested by Amos. Applicants' respectfully note that Aoyama does not disclose a wireless Ethernet network device, or a wireless network

device of any kind. Aoyama is directed to a single chip microcomputer for use in, for example, a video camera. Aoyama is absent of any teaching of a device that transmits and receives data during an active mode and does not transmit and receive data in a low power mode. Combining Aoyama with the MAC device of Amos still does not teach this limitation. Applicants respectfully submit that Claim 1, as well as its dependent claims, should be allowable for at least these reasons.

Claims 91-93, 102, 154-156, 165, 217-218, and 225 are rejected under 35 U.S.C. 103(a) as being unpatentable over Amos in view of Guerlin. This rejection is respectfully traversed.

It is improper to use the inventor's disclosure as an instruction book on how to reconstruct the prior art. **Panduit Corp. v. Dennison Mfg. Co.**, 1 USPQ2d 1593 (Fed. Cir. 1987). Both the suggestion and the expectation of success must be founded in the prior art and not in Applicant's disclosure. **In re Farrell**, 7 USPQ2d 1673 (Fed. Cir. 1988).

Amos is directed to a clock management scheme for a MAC on a PCI or Cardbus bus. The MAC is integrated with the PCI or Cardbus bus. In other words, Amos is directed to a clock management scheme for a MAC that is located within "a PCI based computer system." (Column 4, Line 50). The PCI based computer system is not "a wireless device with active and low power modes."

The Examiner alleges that it would be obvious to combine Amos with the teachings of Guerlin. Guerlin, however, is directed to a mobile telephone. Amos is absent of any teaching of a wireless device including, for example, an oscillator, an RF transceiver, a BBP, and/or any other elements of a wireless device. Amos is directed to

the clock management of a MAC. In contrast, the present invention is directed to managing power and/or frequencies of wireless device components that communicate with the MAC. The MAC is used to transition the other components between the active and low power modes. One skilled in the art would have no motivation to combine Amos, which is directed to clock management of a MAC, with Guerlin, which is directed to power management of components of a mobile telephone, to arrive at the present invention.

Applicants respectfully submit that a combination of Amos and Guerlin is improper. Claim 91, as well as its dependent claims, should be allowable for at least the above reasons.

Claims 103-104, 106-107, 111, 166-167, 169-170, 174, and 226-228 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aoyama in view of Guerlin. This rejection is respectfully traversed.

Aoyama, singly or in combination with Guerlin does not show, teach, or suggest a wireless Ethernet network device with active and low power modes comprising first regulating means for regulating supply voltage during the active mode and that is powered down during the low power mode, second regulating means, which dissipates less power than said first regulating means, for regulating supply voltage during the low power mode, and selecting means for selecting said first regulating means during the active mode and said second regulating means during the low power mode, wherein the wireless Ethernet network device at least one of transmits and receives data during the active mode.

The Examiner alleges that Aoyama discloses a wireless Ethernet network device and that it would be obvious to one skilled in the art to incorporate the controller of Aoyama with an RF transceiver, a BBP, and a shutdown module as suggested by Guerlin. Applicants' respectfully note that Aoyama does not disclose a wireless Ethernet network device, or a wireless network device of any kind. Aoyama is directed to a single chip microcomputer for use in, for example, a video camera. Aoyama is absent of any teaching of a device that transmits and receives data during an active mode and does not transmit and receive data in a low power mode. Combining Aoyama with the RF transceiver, the BBP, and the shutdown module still does not teach this limitation. Applicants respectfully submit that Claim 103, as well as its dependent claims, should be allowable for at least these reasons.

The remaining claims depend either directly or indirectly from claims that the Applicants believe are allowable. Therefore, the remaining dependent claims should be allowable for at least similar reasons.

#### **ALLOWABLE SUBJECT MATTER**

The Examiner states that Claims 18, 48, and 78 would be allowable if rewritten in independent form. Applicants thank the Examiner for the allowable subject matter. Accordingly, Applicants have amended Claims 18, 48, and 78 to include the limitations of the base claim and any intervening claims. Therefore, Claims 18, 48, and 78 should now be in condition for allowance.



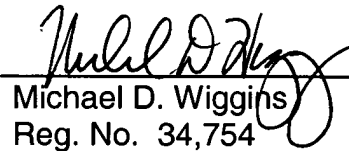
## CONCLUSION

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance. Thus, prompt and favorable consideration of this amendment is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 641-1600.

Respectfully submitted,

Dated: February 1, 2006

By: \_\_\_\_\_

  
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